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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/254,760	04/16/1999	SEISHI KATO	01997.014800	7558

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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/254,760

Applicant(s)

KATO ET AL.

Examiner

Olga N. Chernyshev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

## Attachments:

- \* ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO 413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 5-7 and 9-14 have been cancelled and claims 8, 15, 17 and 18 have been amended as requested in the amendment of Paper No. 18, filed on November 29, 2002.

Applicant is reminded that claims 1-4 have been cancelled as requested in the amendment of Paper No. 9, filed on January 16, 2002. Thus, no additional cancellation of claims 1 and 2 and no amendment to currently cancelled claims 3 and 4 has been made.

Claims 8 and 15-18 are pending and under examination in the instant office action.

2. The Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

4. Applicant's arguments filed on November 29, 2002 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

### ***Claim Rejections - 35 USC § 101***

5. Claim 8 stands rejected under 35 U.S.C. 101 because the claimed invention is drawn to an invention with no apparent or disclosed specific and substantial credible utility for those reasons of record in section 4 of Paper No. 17. Briefly, the instant application has provided a description of an isolated DNA encoding a protein and the protein encoded thereby. The instant

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It is clear from the instant application that the protein described therein is what is termed an "orphan protein" in the art. The DNA of the instant application has been isolated because of its similarity to a known DNA. There is little doubt that, after complete characterization, this DNA and encoded protein may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken, Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct. 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediate obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion".

Applicant traverses the rejection based on the information provided in the document of Yu et al., which describes that a protein comprising the claimed instant polypeptide consisting of amino acids 19 to 175 of SEQ ID NO: 9, is encoded by the colon cancer specific gene

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utilized to determine human cancer" (page 4, fourth paragraph of the Response). This has not been found to be persuasive for the following reasons.

According to Table 1 on page 7 of the instant specification, SEQ ID NOS: 9, 18 and 27 correspond to the clone number HP 10368, "the cells affording the cDNA" (page 7, lines 1-2 of the instant specification), which are stomach cancer cells. Based on this limited information one skilled in the art would not reasonably conclude that the instant polypeptide consisting of amino acids 19 to 175 of SEQ ID NO: 9 has a specific, substantial and credible utility as a marker for stomach cancer. It is obvious that stomach cancer cells express and overexpress a plurality of polypeptides, as well as do other normal cells. The fact that the DNA encoding the claimed polypeptide was isolated from stomach cancerous cells does not make the instant polypeptide specific for stomach cancer. The instant specification, as filed, also fails to provide any evidence or sound scientific reasoning that would support a conclusion that the instant polypeptide is associated with colon cancer, as implied in Applicant's Response or with any other cancers.

Because the instant specification does not teach a biological activity of the claimed protein, which supports a practical utility, and because there is no assertion provided in the specification, as filed, regarding the use of the polypeptide as a marker for any cancer, including stomach cancer, one would not reasonably believe that the polypeptide of the instant invention can be used "to determine human cancer" or use it in any other disclosed methods, such as for production of antibodies. Moreover, to employ a polypeptide of the instant invention in any of the disclosed methods would clearly be using it as the object of further research, which has been

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then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. § 101 as being useful.

***Claim Rejections - 35 USC § 112***

6. Claim 8 stands rejected under 35 U.S.C. 112, first paragraph for reasons of record in section 6 of Paper No. 17. Specifically, since the claimed invention is not supported by either a clear asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***New grounds of rejection necessitated by amendment***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 15, as amended, recites the limitation "the isolated polynucleotide" in claim 8. There is insufficient antecedent basis for this limitation in the claim.

9. Claims 16-18 are indefinite for being dependent from the indefinite claim.

***Conclusion***

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 782-9306 for regular communications and (703) 782-9307 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax

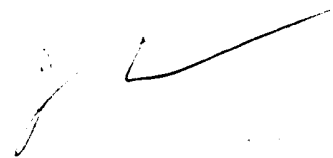
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28, 1993) (see 37 C.F.R. § 1.6(d)0. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D. *le*  
March 7, 2003

A handwritten signature in black ink, appearing to be a stylized 'J' or 'L' followed by a horizontal line.